

I. REAL PARTY IN INTEREST

The real parties in interest are Fib Industries, Inc., Inc. and Dow Corning Corporation by virtue of assignments dated April 17, 2001.

II. RELATED APPEAL AND INTERFERENCES

There are no related appeals or interferences in which Appellants, Appellants' legal representative, or Appellants' assignee which will directly affect or be directly affected by or have a bearing on the Board's decision of this pending appeal.

III. STATUS OF THE CLAIMS

Claims Pending:	Claims 1-18.
Claims Cancelled:	None.
Claims Allowed:	None.
Claims Withdrawn	
from Consideration:	None.
Claims Appealed:	Claims 1-19.

IV. STATUS OF AMENDMENTS

No amendment was filed subsequent to the outstanding Final Rejection of November 12, 2002.

V. SUMMARY OF INVENTION

Appellants' invention is directed to a process of producing a chemically treated filler by contacting an acidic aqueous suspension of an amorphous or particulate inorganic oxide selected from precipitated silica, colloidal silica or mixtures thereof with a coupling agent to form an acidic aqueous suspension of chemically treated filler, optionally in the presence of a surfactant and/or a water miscible solvent, and recovering said filler, the improvement comprises using as said coupling agent a combination of (a) mercaptorganometallic compound and (b) non-

sulfur organometallic compounds in a weight ratio of at least 1:1 of at least 0.05:1 in an aqueous suspension of inorganic oxide having a pH of 2.5 or less, and treating the acidic aqueous suspension of the chemically treated filler with acid neutralizing agents to increase the pH of said suspension to a value of from 3.0 to 10.

VI. THE ISSUES

The issues presented for review by this Appeal are:

1. Whether claims 1-3, 5-8, 10-12, 14-16, and 18 have been properly rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (U.S. Patent 4,436,847) in view of Burns et al. (U.S. Patent 6,051,672);
2. Whether claims 4 and 17 have been properly rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (U.S. Patent 4,436,847) in view of Burns et al. (U.S. Patent 6,051,672) as applied to claim 1 above, and further in view of Cruse et al. (WO 99/09036); and
3. Whether claims 9 and 13 have been properly rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (U.S. Patent 4,436,847) in view of Burns et al. (U.S. Patent 6,051,672) as applied to claims 1 and 10 above, and further in view of Lightsey et al. (U.S. Patent 6,086,061).

VII. SCOPE OF CLAIMS

The claims on appeal stand or fall together.

VIII. ARGUMENT

A. Legal Authority

A proper analysis under Section 103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. In re Vaeck, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

It is now well established by the Federal Circuit that cited prior art must provide one of ordinary skill in the art with the motivation to use the disclosure of a reference in a manner that renders the claims obvious; namely, there must be some teaching suggestion or incentive in the prior art disclosure that supports the rejection. This requirement stands as the critical safeguard against hindsight analysis and rote application of the legal test for obviousness. See, in particular, In re Fausst, 47 USPQ 2d 1453, 1458 (Fed. Cir. 1998). Further, see, In re E.W. Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988), wherein the Court found that "The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art ... With the suggestion

and the expectation of success must be founded in the prior art, not in the applicant's disclosure." See also, *In re Stempel*, 408 F.2d 731, 733, 4 USPQ2d 1071, 1073 Fed. Cir. 1969 wherein the Court found that obviousness cannot be established "by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion that the combination is new." Moreover, in *Ex parte Clapp*, 117 USPQ 471, 473 Bd. Pat. App. & Int'l 1935; the Court found that "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references ... [S]implicity and hindsight are not proper criteria for resolving the issue of obviousness." In *Ex parte Raymond*, 41 USPQ 2d 1217 (Bd. of Appeals 1996), the Court found that it is impermissible to use the claimed invention as an instruction manual or "template" in order to render the claimed invention obvious.

B. The Rejection of Claims 1-3, 5-8, 11-13, 14-16, and 17 under 35 U.S.C. 103(a)

The Examiner has rejected claims 1-3, 5-8, 11-13, 14-16, and 18 under 35 U.S.C. 103(a) as being unpatentable over Wagner (U.S. Patent 4,436,847) in view of Burns et al. (U.S. Patent 6,351,672). Appellants submit that these references taken either alone or in combination do not fairly suggest the claimed invention.

Appellants submit that the Wagner '847 patent does not disclose the pH at which the silane coupling composition is added to the rubber compound, and further, this reference does not suggest adjusting the pH of the reaction mixture. Moreover, a reason or purpose for adjusting the pH is not suggested. Thus, there would be no motivation for one of ordinary skill in the art at the time of the invention to modify the disclosure in the Wagner

'847 patent by looking to the pH range disclosed in the Burns et al. '672 patent. Based on the legal authority recited above, the Wagner '847 patent does not disclose the requisite "suggestion or incentive," nor does the patent disclose the "suggestion and the expectation of success" to support combining the pH range disclosed in the Burns et al. '672 patent with the method taught by the Wagner '847 patent. The combination of these two references requires impermissible hindsight, thus rendering the rejection improper.

Furthermore, the Burns et al. '672 reference teaches conducting the reaction of colloidal silica with silicon compound at a pH of less than 4. However, the Burns et al. '672 reference does not disclose, nor even suggest, increasing the pH following completion of the aforementioned chemical reaction, as in the claimed invention. None of the Examples in the Burns et al. '672 patent recite any pH values. Thus, Appellants submit that it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure in the Wagner '847 patent by looking to the pH range disclosed in the Burns et al. '672 patent, to obtain the claimed invention.

Appellants submit that in view of the above remarks, the claimed invention would not have been obvious to one of ordinary skill in the art at the time. Further, without impermissible hindsight reconstruction, there would be no motivation for one of ordinary skill to combine the teachings of Wagner and Burns to produce the claimed invention. Moreover, the claimed invention is not even remotely suggested by the Wagner and Burns references taken either alone or in combination.

C. The Rejection of Claims 4 and 17 under

35 U.S.C. 103(a)

The Examiner has rejected claims 4 and 17 under 35 U.S.C. 103(a) as being unpatentable over Wagner (U.S. Patent 4,436,847) in view of Burns et al. (U.S. Patent 4,131,872) as

applied to claim 2 above, and further in view of Cruse et al. '89/09036. Appellants submit that these references taken either alone or in combination do not fairly suggest the claimed invention.

Appellants submit that neither the Wagner '847 patent nor the Burns et al. '672 patent discloses blocked mercaptosilanes as coupling agents and further, the use of blocked mercaptosilanes is not even suggested in these two references. Moreover, a reason or purpose for using blocked mercaptosilanes is not suggested. Thus, there would be no motivation for one of ordinary skill in the art at the time of the invention to modify the disclosure in the Wagner '847 patent by looking to the Burns et al. '672 patent, and the Cruse et al. '036 publication. Based on the legal authority recited above, neither the Wagner '847 patent nor the Burns et al. '672 patent discloses the requisite "teaching suggestion or incentive..." nor does the patent disclose the "suggestion and the expectation of success" to support combining the blocked mercaptosilanes disclosed in the Cruse et al. '036 publication with the methods taught by the Burns et al. '672 patent and the Wagner '847 patent. The combination of these references requires impermissible hindsight, thus rendering the rejection improper.

Appellants submit that in view of the above remarks, the claimed invention would not have been obvious to one of ordinary skill in the art at the time. Further, without impermissible hindsight reconstruction, there would be no motivation for one of ordinary skill to combine the teachings of Wagner, Burns and Cruse to produce the claimed invention. Moreover, the claimed invention is not even remotely suggested by the Wagner, Burns and Cruse references taken either alone or in combination.

2. The Rejection of Claims 9 and 13 under

35 U.S.C. 103(a)

The Examiner has rejected claims 9 and 13 under 35 U.S.C. 103(a) as being unpatentable over Wagner U.S. Patent

4,436,847) in view of Burns et al. U.S. Patent 2,131,722 as applied to claims 6 and 12 above, and further in view of Lightsey et al. U.S. Patent 3,985,953. Appellants submit that these references taken either alone or in combination do not fairly suggest the claimed invention.

Appellants submit that the use of precipitated silica is not even suggested by the Wagner '847 patent nor the Burns et al. '672 patent. Moreover, a reason or purpose for using precipitated silica is not suggested by these two references. Thus, there would be no motivation for one of ordinary skill in the art at the time of the invention to modify the disclosure in the Wagner '847 patent by looking to the Burns et al. '672 patent, and the Lightsey '953 patent. Based on the legal authority recited above, neither the Wagner '847 patent nor the Burns et al. '672 patent discloses the requisite "teaching suggestion or incentive" nor does the patent disclose the "suggestion and the expectation of success" to support combining the precipitated silica disclosed in the Lightsey et al. '953 patent with the methods taught by the Burns et al. '672 patent and the Wagner '847 patent. The combination of these references requires impermissible hindsight, thus rendering the rejection improper.

Appellants submit that in view of the above remarks, the claimed invention would not have been obvious to one of ordinary skill in the art at the time. Further, without impermissible hindsight reconstruction, there would be no motivation for one of ordinary skill to combine the teachings of Wagner, Burns and Lightsey to produce the claimed invention. Moreover, the claimed invention is not even remotely suggested by the Wagner, Burns and Lightsey references taken either alone or in combination.

IV. CONCLUSION

Allowance of the appealed claims is warranted based on the controlling facts and applicable law. For the reasons stated, the Examiner erred in rejecting the claims. The Examiner's Final Rejection should, therefore, be reversed and the claims on appeal allowed.

Respectfully submitted,

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